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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,115	07/18/2003	Michel John Arthur Groux	88265-6859	1635
29157 7590 11/01/2007 BELL, BOYD & LLOYD LLP P.O. Box 1135 CHICAGO, IL 60690			EXAMINER CHAWLA, JYOTI	
			ART UNIT 1794	PAPER NUMBER
			NOTIFICATION DATE 11/01/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/622,115	Applicant(s) GROUX ET AL.	
	Examiner Jyoti Chawla	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 14, 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12 and 14-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendment filed on August 14, 2007 has been entered. Claims 1 and 12 have been amended, claim 13 has been cancelled and claims 1, 3-12, 14-17 are pending and examined in the application.

Claim Rejections - 35 USC § 112

Rejection of claims 1, 3-17 rejected under 35 U.S.C. 112, first paragraph, for the recitation of "wherein the milk product is high temperature processed and is room temperature stable" has been withdrawn in light of applicant's amendments filed August 14, 2007.

Rejection of claims 1, 3-17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for the recitation of "high temperature processing" of the milk product has been withdrawn in light of applicant's amendments filed August 14, 2007.

Claim Rejections - 35 USC § 102/103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1) Claims 1, 5, 8, 10 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jonas (US 4,012,533).

Regarding claims 1 and 8, Jonas teaches of a milk product comprising 0-15% fat (claimed range 0-40%), 3-10% protein (i.e., non-fat solids, claimed range 5-23%), which includes non-fat dry milk (Column 5, lines 17-25, Column 5, lines 59-61), at least two emulsifiers (Column 6, lines 30-33), a stabilizer and water as instantly claimed. Jonas teaches emulsifiers and combinations of emulsifiers including propylene glycol monostearate, mono and diglycerides, etc (Column 4, lines 22-34). Suitable stabilizers include alginates, carboxymethylcellulose, etc (Column 5, lines 2-6). Sodium alginate is

utilized in a whipped milk based dessert as a stabilizer (Column 9, Table 1 and lines 45-46) as instantly claimed. Jonas teaches that the milk product does not exhibit syneresis or foam breakdown upon holding at room temperature for as long as 6 to 8 hours and exhibits the physical and organoleptic properties of whipped topping (Column 2, lines 60-65). Jonas also teaches of high temperature processing as recited in the newly added limitation to claim 1. Jonas teaches a pasteurizing step in making the milk product (Column 9 and Column 11, line 40), i.e., high temperature processing, as instantly claimed. Therefore, Jonas anticipates instantly claimed milk product.

Alternatively, Jonas teaches of a milk product comprising fat and non-fat solids (proteins) in the range recited by the applicant, emulsifiers, stabilizers and water as recited by the applicant (see the rejection above). The applicant has neither defined what is considered to be "stable" nor specified the time for which the product is required to be stable at room temperature. Regarding the room temperature stability, Jonas teaches that the milk product does not exhibit syneresis or foam breakdown upon holding at room temperature for as long as 6 to 8 hours (Column 2, lines 60-65). Based on the teachings of Jonas and the recitation of the claim, it would have been obvious to one of ordinary skill at the time of the invention that the foamed milk product taught by Jonas, which does not show foam breakdown at room temperature for 6-8 hours, is a room temperature stable product as instantly claimed.

Jonas also teaches of high temperature processed food product by teaching pasteurization step in the processing of the milk product (Column 9 and Column 11, line 40). Claim 1 is directed to a product and as recited the applicant does not specifically claim when the milk based product is subjected to pasteurization or other heat treatment. It is noted that pasteurization, sterilization or UHT were known in the art at the time of the invention as methods of obtaining and ensuring microbial safety of foods for human consumption. Therefore, it would have been a matter of routine optimization for one of ordinary skill in the art at the time of the invention to subject the milk based product to a heat treatment, such as pasteurization, as late as possible in the processing of the milk product in order to make a product which is microbiologically safe

for human consumption at the time of production and remains fit for human consumption during transportation and storage.

Regarding claim 5 and 8, Jonas teaches of suitable emulsifiers including propylene glycol monostearate (Column 4 lines 22-34) that can be utilized at a range of 0.3 to 0.7% (Column 3 lines 40-45) as instantly claimed.

Regarding claim 10, Jonas teaches of non-dairy fat such as vegetable oils including soybean oil, palm oil, etc (Column 4 lines 1-5).

Regarding claim 11, Jonas teaches of additional ingredients in the milk product including flavorings, coloring agents, etc (Column 7 lines 36-38) as instantly claimed.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(A) Claims 3-4, 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonas in view of Gonsalves et al (U.S. 6,033,711).
Jonas has been applied to claims 1, 5, 8 and 10 and 11 above.

The references and rejection are incorporated herein and as cited in the office action mailed June 25, 2007.

(B) Claims 9 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonas in view of Gonsalves further in view of Lynch (U.S. 5,759,609).

Jonas has been applied to claims 1, 5, 8 and 10 and 11 as discussed above. Jonas in view of Gonsalves has been applied to claims 3-4 and 6-7.

The references and rejection are incorporated herein and as cited in the office action mailed June 25, 2007.

(C) Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonas in view of Gonsalves further in view of the combination of Lynch (U.S. 5,759,609) and Thompson (U.S. 3,230,091).

Jonas has been applied to claims 1, 5, 8 and 10 and 11 above. Jonas in view of Gonsalves has been applied to claims 3-4 and 6-7.

The references and rejection are incorporated herein and as cited in the office action mailed June 25, 2007.

Response to Arguments

Applicant's arguments filed August 14, 2007 have been fully considered but they have not been found persuasive.

I) Applicant's remarks regarding the rejection under 35 USC 112 (Remarks, pages 5-6) have been considered and responded to in the office action above.

II) Applicant's argument that Jonas fails to disclose or suggest every element of the amended claims (Remarks page 6, last paragraph), has been considered and responded to in the office action above.

III) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "milk based foamed composition that remains stable *for a while* once poured or deposited onto the surface of a beverage, especially a hot beverage like coffee, tea or

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chocolate, and that acts simultaneously as a beverage whitener/foamer" Remarks, page 7) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding applicant's remarks on page 7, paragraph 1 about the claimed invention including "milk based foamed composition that remains stable *for a while* once poured or deposited onto the surface of a beverage, especially a hot beverage like coffee, tea or chocolate, and that acts simultaneously as a beverage whitener/foamer" ; "Applicants have surprisingly found that a stable milk product with foamability at room temperature can be achieved by means of duly selected emulsifiers which belong to distinct categories or chemical classes, i.e. propylene glycol saturated fatty acid esters, sorbitan saturated fatty acid esters and unsaturated monoglycerides" and "Foam stability (once the foam is poured onto the beverage surface) can be achieved by means of duly selected foam stabilizers, namely a combination of microcrystalline cellulose (MCC) and carboxymethylcellulose (CMC) or sodium alginate", applicant is reminded that the features of applicant's statements are not recited as such in the rejected claims. The independent claim 1 recites a milk based product that can be foamed, however, "milk based foamed composition that remains stable *for a while* once poured or deposited onto the surface of a beverage, especially a hot beverage like coffee, tea or chocolate, and that acts simultaneously as a beverage whitener/foamer" is not recited in the claims.

Similarly, at least two emulsifiers "selected from a group consisting of propylene glycol monostearate, sorbitan tristearate unsaturated monoglyceride and combinations thereof" has been claimed and not the entire classes of emulsifiers belonging to distinct categories, i.e. propylene glycol *saturated fatty acid esters*, sorbitan *saturated fatty acid esters* as stated in the remarks on page 7.

IV) Applicant's argument that Jonas fails to teach "room temperature stable milk product that provides a foamed composition" (Remarks, page 7, paragraphs 2-3) is not persuasive because Jonas teaches that the milk product does not exhibit syneresis or

foam breakdown upon holding at room temperature for as long as 6 to 8 hours and exhibits the physical and organoleptic properties of whipped topping (Column 2, lines 60-65) as discussed in the office action above. It is noted that applicant's invention is stated as a "composition that remains stable for a while" (Remarks, page 7, line 3) and Jonas teaches no foam disintegration or syneresis for 6-8 hours at room temperature, which falls in the range of "a while". Further it is noted that the applicant has not clarified the term "stable" and also the time period for which the composition remains stable, therefore the two terms have been given the broadest reasonable interpretation by the office. Thus Jonas teaches of room temperature stable foamed milk based composition as instantly claimed, absent any clear and convincing evidence and/or arguments to the contrary.

V) Applicant's argument that "Jonas also fails to disclose or suggest a milk product that is high temperature processed using a process selected from the group consisting of pasteurization, sterilization, UHT treatment and combinations thereof as required" (Remarks, page 8, paragraphs 1 and 3) is not persuasive because Jonas teaches of pasteurization (i.e., high temperature processing) of the fat emulsion as well as the milk based protein emulsion in the process of making the milk based composition (Column 9 and 11). Regarding the order of step of high temperature treatment, the claim, as recited, does not specify when the high temperature treatment step takes place, thus a high temperature treatment, such as pasteurization, performed anytime during the process of making the milk based foamed composition would meet applicant's claim as recited. Furthermore, pasteurization of milk products is performed routinely during processing for food safety reasons, and it would have been a matter of routine optimization for one of ordinary skill in the art at the time of the invention to subject the milk based product to a heat treatment, such as pasteurization, as late as possible in the processing of the milk product in order to make a product which is microbiologically safe for human consumption at the time of production and remains fit for human consumption during transportation and storage. Furthermore, regarding Jonas only pasteurizing the protein emulsion (Remarks, page 8), applicant is referred to claim 1,

which includes the fat range of 0-40%, which includes 0% fat, i.e., no fat, thus milk based protein emulsion as taught by Jonas would be considered as a milk product, which would be a non fat product and would still be applicable as prior art. Thus applicant's claim would have been obvious over Jonas, absent any clear and convincing evidence and arguments to the contrary.

VI) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "high temperature treating of the *final mixture* prior to packaging" and also "heating milk product with the addition of emulsifiers" page 8, paragraphs 1-2) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

VII) In response to applicant's arguments against the references individually (Remarks, Page 9), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Regarding the rejection of claims 12-14, Jonas teaches of mixing the emulsifiers/ stabilizers with the non-fat milk before pasteurization (Jonas, Column 9) and Gosalves teaches of the specific emulsifier sorbitan tristearate at a range from 0.03 to 0.19% (Column 2 lines 52-53) in a milk product such as whipped topping as discussed in the office action dated June 25, 2007. Further, The claims call for the presence of emulsifier. Emulsifiers and stabilizers are well known in making of stable emulsions comprising milk as discussed in the office action. The addition of same is not seen as a patentable distinction but merely an ingredient incorporated for it's own art recognized contribution of composition, for example, emulsifying fat in the composition and producing a stable foam. It would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated such ingredients as a matter of preference depending on, for example, availability, cost, desirable

stiffness in the foam. New recipes for food involving the addition of common ingredients do not amount to invention merely because the coaction or cooperative relationship between the ingredients which produces new, unexpected, and useful function. In re Levin, 84 USPQ 232.

VIII) Regarding applicant's arguments that the Gonsalves reference teaches away from applicant's invention (Remarks page 9) has not been found persuasive, because Gonsalves teaches of fat-free, i.e., 0% fat or higher, which is in the range of fat content recited in the claims. Regarding Gonsalves teaching away because Gonsalves teaches of "preferably non-dairy", the applicant is referred to the rejection details in the previous office action dated June 25, 2007 where the combination of references has been relied to reject applicant's claims. In response to applicant's argument that Gonsalves does not teach the claimed invention, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Therefore, applicant's arguments have been fully considered and have not been found persuasive and claims 1, 3-12, 14-17 have been rejected for the reasons of record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

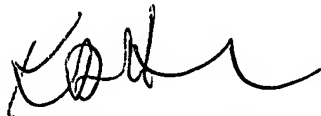
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Chawla whose telephone number is (571) 272-8212. The examiner can normally be reached on 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jyoti Chawla
Examiner
Art Unit 1794



KEITH HENDRICKS
PRIMARY EXAMINER